

RESULTS

Status of the claims:

With the above amendments, claim 5 has been canceled and claim 1 has been amended. Thus, claims 1-4 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Claim 1 has been amended by incorporation of the subject matter of claim 5. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §103

Claims 1-3 are rejected under 35 USC §103(a) as being unpatentable over Hayashi '169 (US Patent No. 6,468,169).

Applicant traverses.

Present Invention

The present invention, as recited in claim 1, relates to a multi-piece solid golf ball comprising a core consisting of a center, an intermediate layer formed on the center and an outer layer formed on the intermediate layer, and a cover covering the core, wherein

the center has a diameter of 10 to 19 mm and a central point hardness in JIS-A hardness of 30 to 80,

the intermediate layer has a surface hardness in Shore D hardness of 30 to 55,

the outer layer has a hardness in Shore D hardness of 55 to 70, and

the cover has a Shore D hardness of 35 to 55 and a thickness of 0.3 to 1.5 mm.

Disclosure of Hayashi '169

Hayashi '169 discloses a multi-piece solid golf ball comprising a core consisting of an inner sphere and an enclosure layer surrounding the inner sphere and a cover surrounding the core. The golf ball consists of an outer layer and an inner layer that is characterized in that the outer layer of the cover has a hardness of 40-60 in Shore D, the inner layer of the cover has a hardness of 55-70 in Shore D, the surface hardness of the enclosure layer is higher in Shore D than the surface hardness of the inner sphere. Moreover, the inner sphere has a hardness expressed by a distortion of 3.0-8.0 mm under an applied load of 100 kg, and the ratio of the hardness A of the inner sphere to the hardness B of the ball, both expressed by a distortion under an applied load of 100 kg, is in the range: $1.1 \leq A/B \leq 3.5$.

Removal of the Rejection over Hayashi '169

Applicant respectfully notes that the Examiner has not rejected claims 4 and 5 under this rejection. Applicant thus believes that the incorporation of claim 5 into independent claim 1 should obviate the rejection. For this reason alone, withdrawal of the rejection is warranted and respectfully requested.

Moreover, Applicant notes that the inner sphere of the golf ball of Hayashi '169 is from 20 to 37 mm, which fails to overlap at all with that of the claimed center (in claim 1) of 10 to 19 mm.

Accordingly, with this amendment, Applicant asserts that the Examiner has failed to make out a *prima facie* case of obviousness with regard to the 35 USC §103(a) rejection over Hayashi '169. Three criteria must be met to make out a *prima facie* case of obviousness.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP §2142 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). With the above amendments, none of the above elements are met. There is no suggestion or motivation to modify the reference so that the inner sphere of the golf ball is from 10 to 19 mm. In this regard, please note that at column 4, lines 5-9, Hayashi '169 recites:

Also the inner sphere preferably has a diameter of 20 to 37 mm, more preferably 22 to 35 mm. It is understood that the specific gravity, weight and other parameters of the inner sphere may be properly adjusted insofar as the objects of the invention are achievable.

From this passage it should be apparent to one of ordinary skill in the art that the preferred embodiment wherein the inner sphere is from 22 to 35 mm is even further away from the instantly claimed invention than the broader range. Accordingly, there is motivation in Hayashi '169 that teaches away from the instant invention.

Second, because there is no suggestion in Hayashi '169 to modify the golf ball to have an inner sphere as claimed in the instant invention, there can be no expectation of success.

Third, all of the elements are not present in Hayashi '169. Hayashi '169 fails to disclose or suggest a golf ball with an center that is 10 to 19 mm. Accordingly, the third element is not present to make a proper *prima facie* obviousness rejection. Because none of the elements necessary to make a proper *prima*

facie case of obviousness are present, withdrawal of the rejection is warranted and respectfully requested.

Double Patenting

Claims 1-5 are rejected under the judicially created non-statutory obviousness-type double patenting over claims 1-5 of co-pending Application No. 10/638,307. Attached to this response, please find a terminal disclaimer in association with co-pending Application No. 10/638,307. Applicant believes that with this terminal disclaimer that this rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, Applicant believes that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for one (1) month extension of time for filing a response in connection with the

present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Terminal Disclaimer